



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/692,746

10/27/2003

Itaru Furukawa

50063-069

8831

7590 08/25/2009  
McDERMOTT, WILL & EMERY  
600 13th Street, N.W.  
Washington, DC 20005-3096

EXAMINER

YUAN, KATHLEEN S

ART UNIT

PAPER NUMBER

2624

MAIL DATE

DELIVERY MODE

08/25/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/692,746	<b>Applicant(s)</b> FURUKAWA ET AL.	
	<b>Examiner</b> KATHLEEN S. YUAN	<b>Art Unit</b> 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 1-11, 16-29 and 34-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-15 and 30-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

The response received on 7/31/2009 has been placed in the file and was considered by the examiner. An action on the merit follows.

#### ***Response to Amendment***

1. The amendments filed on 2009 July 31 have been fully considered.

Response to these amendments is provided below.

#### **Summary of Amendment/ Arguments and Examiner's Response:**

2. *The applicant has amended the claims in attempt to overcome the prior art rejection. First of all, the applicant amends claim 12 to clarify that the steps are done by a prepress system.*

3. Although the applicant has tied the steps to something, the applicant does not tie the steps to a "particular machine" and therefore does not overcome the prior art rejection. Further explanation is provided in the rejection below.

4. *The applicant argues that there is support for the amended clarification in paragraphs 72-74. The applicant states that" the signature/imposition processor 320 prepares preliminary proof RIP data RIPD2 by executing RIP processing on signature/ imposition processed print image data PD2 without performing a proofreading of the RIP data RIPD1."*

5. The examiner has reviewed the cited paragraphs in detail, and also the specification as a whole. The examiner is unclear as to how the claim is mapping to the specification. From the arguments, it seems like the applicant is

Art Unit: 2624

stating that RIPD1 corresponds to the claimed "first print image data" and RIPD2 corresponds to the "second print image data," and that the signature/ imposition processing of S12 corresponds to the claimed "another prepress processing."

What is claimed is that second print image data is obtained by carrying out another prepress processing to the first print image data. This does not correspond to fig. 3, since RIPD2 is not obtained from applying the signature imposition processing of RIPD1; PD2 is obtained by using the signature/imposition processing on PD1. If it is interpreted that "first print image data" corresponds to the PD1 and "second print image data" corresponds to PD2, then the "signature/ imposition processing" does create a second print image data. However, the another prepress processing excludes correction after client's proofreading. The signature/ imposition processing does not exclude correction after client's proofreading, since the client's proofreading is carried out in s11, and signature/imposition processing is a type of correction since the size is corrected, as disclosed in paragraph 59 of page 3. Therefore, it is still unclear as to how the applicant is mapping the claims to the specification, and where this is enabled.

6. *The applicant argues that Katsuya performs proofreading, and that Date and Kitamura fail to cure the deficiencies.*

7. The examiner disagrees. Date and Kitamura both disclose means of changing the data that excludes correction after proofreading, as explained in the previous rejection, and as explained below.

***Drawings***

8. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, all features in the claim must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. The features that are not shown are those that are rejected in the written description below, but also, even if that were enabled, the preparation of first and second plate image inspection RIP data and the comparison of the data is not shown in the figures, especially utilizing the RIDD2 and RIDD2, as the applicant asserted is mapped to part of the claim in the arguments.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

Art Unit: 2624

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**10.** Claims 12-15 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent<sup>1</sup> and recent Federal Circuit decisions<sup>2</sup> indicate that a statutory “process” under 35 U.S.C. 101 must (1) be tied to an apparatus or a machine or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. Furthermore, the tie must be meaningful. A machine tied only to an intended use statement or to insignificant pre or post solution activity is not a meaningful tie. The tie must be in relation to a step or steps that are significant to the invention, or basic inventive concept. The applicant has attempted to overcome the rejection by tying the steps to “a printing prepress system,” however, a system is not a particular machine and can

---

<sup>1</sup> *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

<sup>2</sup> *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

Art Unit: 2624

be embodied by a computer program, which is not a particular machine. Please tie the claim to a particular machine, i.e. a processor or computer carrying out the claimed steps.

***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claim 12-15 and 30-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As explained above, the examiner cannot find support in the specification that states the another prepress processing step to get the second print image data excludes correction after proofreading done by a client. As explained in the arguments in the final rejection dated 4/2/2009, preflight processing, or s11 of fig. 4 is a type of proofreading. As explained in the arguments above, the signature/imposition processing is a correction. Therefore, s12 of fig. 4 is a correction after client's proofreading. Therefore, it is unclear as to how one excludes correction after proofreading in the claim when the specification directly conflicts with the claim.

---

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 12 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Abstract and machine translation of Publication No. 10-154234 (Katsuya et al) in view of U.S. Patent No. 5473748 (Date et al) or U.S. Patent No. 5418894 (Kitamura et al).

15. Regarding claim 30, Katsuya et al discloses a prepress system (title) comprising: a first RIP processor for preparing a first RIP data, that which processes the page description data that is saved as the first proofreading (abstract), by executing RIP processing, obtaining raster conversion (abstract), on a first print image data according to first RIP processing condition of bring the initial image data (abstract), a second RIP processor for preparing a second RIP data, that which processes the second proofreading (abstract) by executing RIP processing, in accordance with second RIP processing conditions that differ from the first RIP processing conditions, the conditions being that the image is corrected in result of proofreading, on a second print image data obtained by carrying out another prepress processing, the processing occurring before printing, and is therefore prepress processing (paragraph 2) to the first print



Art Unit: 2624

image data, the prepress processing being the correction to obtain the latest page description data (abstract); a converter for preparing a first plate image-inspection RIP data, that which converts the data in a value of density by pixel (abstract), in accordance with standard RIP processing conditions by converting the first RIP data using a first profile representing relationship between the standard RIP processing conditions and the first RIP processing conditions by converting the data into density by the pixel, therefore comparing the standard RIP known conditions of if a pixel is a certain way, then it is converted to a certain density to the first RIP processing conditions of being the initial data and using the initial data as what is converted (abstract), and for preparing a second plate image-inspection RIP data, the second proofreading that is converted by density (abstract) in accordance with the standard RIP processing conditions by converting the second RIP data, using a second profile representing relationship between the standard RIP processing conditions and the second RIP processing conditions, as explained above for the first RIP processing conditions, except the second RIP processing conditions are used in the second plate image-inspection data; and a comparator for comparing the first and second plate-image-inspection RIP data to detect differences between the first and second print image data, that which performs the comparison by the pixel (abstract). Furthermore, the comparison is made in order to find the part that is changed by the proofreading.

Katsuya et al does not disclose expressly that the another prepress processing step excludes client's correction after proofreading.

Art Unit: 2624

Date et al or Kitamura et al discloses another process in which second print image data is obtained by carrying out the process of adding ornamental effects (date et al, col. 1, lines 24-26) or changing the tint (Kitamura et al, col. 1, lines 20-25), which is not a client's correction after proofreading; it is a preference change by the user.

Katsuya et al and Date et al or Kitamura et al are combinable because they are from the same field of endeavor, i.e. prepress processing.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use a prepress process that excludes correction after proofreading.

The suggestion/motivation for doing so would have been to provide a more flexible system by allowing the system to check for all changes that is made to the data, including elective changes by a user.

Furthermore, KSR vs. Teleflex Co dictates that simple substitution of one known element for another to obtain predictable results is obvious. Katsuya et al disclosed a known method/ device that differs from the claimed device only in that the process excludes correction after proofreading. The substituted component is an elective process that changes the print image data such as the tint or ornamental effects were known in the art, as shown by Date et al and Kitamura et al. One of ordinary skill in the art could have substituted the correction after proofreading process with the elective process, and the results would have been predictable, a result of finding the part that is changed from the process of changing color, or ornamental effects.

Therefore, it would have been obvious to combine the system of finding changes in RIP data of Katsuya et al with the prepress processing of Date et al or Kitamura et al to obtain the invention as specified in claim 30.

16. Claim 12 is rejected for the same reasons as claim 30. Thus, the arguments analogous to that presented above for claim 30 are equally applicable to claim 12. Claim 12 distinguishes from claim 30 only in that claim 30 is a system and claim 12 is a method in which the steps are carried out by the system. Since a system of claim 30 carries out a method, prior art applies.

17. Claims 12-13 and 30-31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Katsuya et al in view of Date et al or Kitamura et al, as applied to claims 12 and 30 above, in view of U.S. Patent Application Publication No. 20030026457 (Nahum). Claims 12 and 30 are reinterpreted below.

Regarding claim 30, Katsuya et al discloses all of the claimed elements as set forth above and incorporated herein by reference. Katsuya et al further discloses another way of interpreting the processing conditions, as with resolution. Katsuya et al's first processing condition would be the resolution in which the first RIP data is obtained, and the second processing condition would be the resolution in which the second RIP data is obtained, which can differ (paragraph 43). Katsuya et al further discloses that the resolutions can be converted to match to the image with the lowest resolution (paragraph 43).

Art Unit: 2624

Therefore, the first and second plate-image-inspection RIP data can be interpreted as the converted image with matching resolution.

Katsuya et al does not disclose expressly that the another prepress processing step excludes client's correction after proofreading.

Date et al or Kitamura et al discloses another process in which second print image data is obtained by carrying out the process of adding ornamental effects (date et al, col. 1, lines 24-26) or changing the tint (Kitamura et al, col. 1, lines 20-25), which is not necessarily a correction after proofreading; it is a preference change by the user.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use a prepress process that excludes correction after proofreading.

The suggestion/motivation for doing so would have been to provide a more flexible system by allowing the system to check for all changes that is made to the data, including elective changes by a user.

Furthermore, KSR vs. Teleflex Co dictates that simple substitution of one known element for another to obtain predictable results is obvious. Katsuya et al disclosed a known method/ device that differs from the claimed device only in that the process excludes correction after proofreading. The substituted component: an elective process that changes the print image data such as the tint or ornamental effects were known in the art, as shown by Date et al and Kitamura et al. One of ordinary skill in the art count have substituted the correction after proofreading process with the elective process, and the results

Art Unit: 2624

would have been predictable, a result of finding the part that is changed from the process of changing color, or ornamental effects.

Interpreting “processing conditions” as resolution (as in claim 31) Katsuya et al (as modified by Date et al or Kitamura et al) does not disclose expressly both first and second plate-image-inspection RIP data are converted into a standard resolution, therefore, using a first/second profile representing relationship between the standard RIP processing conditions and the first/second RIP processing condition since in order to convert the first/ second data to a standard resolution, a relationship would be found to find how the first/second resolutions compare to the standard resolution.

Nahum discloses before comparing images of different resolution, converting both the images to a standard resolution, lower resolution (page 1, paragraph 9).

Katsuya et al (as modified by Date et al or Kitamura et al) and Nahum are combinable because they are from the same field of endeavor, i.e. comparison of images.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to reduce the resolution in both images to a standard, lower resolution.

The suggestion/motivation for doing so would have been to provide a faster system by lowering the computational load.

Therefore, it would have been obvious to combine the image matching system of Katsuya et al (as modified by Date et al or Kitamura et al) with the

Art Unit: 2624

lowering of resolution in comparison images of Nahum to obtain the invention as specified in claim 30.

18. Regarding claim 31, Nahum discloses the standard RIP processing conditions include, as a parameter, a resolution lower than a resolution in the initial images to be compared (page 1, paragraph 9). Katsuya et al a final outputting step of outputting raster data of a high resolution, indicating a resolution of the initial images (paragraph 43). Therefore, the combination of Nahum and Katsuya et al discloses that the standard resolution is lower than the final output.

19. Claims 12 and 13 are rejected for the same reasons as claims 30 and 31, respectively. Thus, the arguments analogous to that presented above for claims 30 and 31 are equally applicable to claims 12 and 13. Claims 12 and 13 distinguish from claims 30 and 31 only in that claims 30 and 31 are systems and claims 12 and 13 are methods. Since a system carries out a method, prior art applies.

20. Claims 14-15 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsuya et al in view of Date et al or Kitamura et al, as applied to claims 12 and 30 above, and further in view of U.S. Patent No. 5969798 (Nakagawa et al).

Regarding claim 32, Katsuya et al (as modified by Date et al or Kitamura et al) discloses all of the claimed elements as set forth above and incorporated herein by reference.

Katsuya et al (as modified by Date et al or Kitamura et al) does not disclose expressly each of the first and second print image data represent an image in which at least one print page is laid out on a mount area in accordance with specified page layout conditions, and the prepress system further comprises: an image region extracting section for extracting an image region corresponding to a same print page from each print image data, based on the page layout conditions specified for each print image data.

Nakagawa et al discloses a plate inspection system that obtains first and second print image data, like Katsuya (fig. 5, s1, s2) which are inspected (fig. 5, s4). The first and second image data represent an image in which at least one print page is laid out on a mount area in accordance with specified page layout conditions (fig. 6, s102), and the prepress system further comprises an image extracting section for extracting an image region corresponding to a same print page from each print image data by reading the full page image data, and thus extracting the regions of the page (fig. 6 and fig. 7) based on the page layout conditions specified for each print image data (fig. 6, s102 precedes the reading in fig. 6 and fig. 7). The extracting section can also be interpreted as that which extracts the position of the alignment marks (fig. 8, s302).

Katsuya et al (as modified by Date et al or Kitamura et al) and Nakagawa et al are combinable because they are from the same field of endeavor, i.e. reading plate images for inspection.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to extract regions of the image for inspection.

The suggestion/motivation for doing so would have been to provide the most accurate and robust inspection by considering all relevant areas of the page.

Therefore, it would have been obvious to combine the system of Katsuya et al (as modified by Date et al or Kitamura et al) with the page layout conditions and extraction of Nakagawa et al to obtain the invention as specified in claim 32.

21. Regarding claim 33, Nakagawa et al discloses the image region extracting section (fig. 8) is configured to rotate the image region of at least one of the first and second print image data so that layout angles of the same print page for the first and second print image data become equal to each other (fig. 8, s306 and 307).

22. Claims 14 and 15 are rejected for the same reasons as claims 32 and 33, respectively. Thus, the arguments analogous to that presented above for claims 32 and 33 are equally applicable to claims 14 and 15. Claims 14 and 15 distinguish from claims 32 and 33 only in that claims 32 and 33 are systems and claims 14 and 15 are methods. Since a system carries out a method, prior art applies.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KATHLEEN S. YUAN whose telephone number is (571)272-2902. The examiner can normally be reached on Monday to Thursdays, 9 AM to 5 PM.



Art Unit: 2624

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Werner can be reached on (571)272-7401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bhavesh M Mehta/  
Supervisory Patent Examiner, Art Unit 2624

/KY/  
8/24/2009